

REMARKS

This application has been carefully reviewed in light of the Office Action dated April 20, 2004. Claims 1-9 remain pending in this application. Claims 1 and 9 are the independent claims. Favorable reconsideration is respectfully requested.

In response to the Office Action's objection to the specification for failing to provide subtitles, Applicant gratefully acknowledges the Office Action's suggestion; however respectfully decline to add the headings, as they are not required in accordance with MPEP §608.01(a).

In response to the objections to Claims 1-7 as not defining a clear preamble and not clearly expressing whether functions are achieved, Applicant respectfully believes the amendments to Claims 1-7 adequately respond to the objections and render them moot. Applicant respectfully requests withdrawal of the objections to Claims 1-7. In response to the objection to Claim 7 as being improper because a multiple dependent claim cannot depend from any other independent claim, Applicant respectfully traverse this objection as erroneous, as multiple dependencies were removed in the preliminary amendment filed on December 13, 2000. Applicant respectfully requests withdrawal of the objection to Claim 7.

On the merits, the Office Action rejected Claim 2 under 35 U.S.C. § 112, second paragraph as being indefinite for ailing to

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particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant respectfully believes the amendment to Claim 2 adequately responds to the § 112, second paragraph rejection and requests its withdrawal.

Further on the merits, the Office Action rejected Claims 1, 2, and 9 under 35 U.S.C. § 102(b) as being anticipated by Chieu et al., (U.S. Patent No. 5,515,366; hereinafter "Chieu"). The Office Action also rejected Claims 3, 6, and 8 under 35 U.S.C. § 103(a) as being unpatentable over Chieu in view of Magana (U.S. Patent No. 5,956,326; hereinafter "Magana"). The Office Action also rejected Claims 4-5 under 35 U.S.C. § 103(a) as being unpatentable over Chieu in view of Miyake et al. (U.S. Patent No. 5,903,618; hereinafter "Miyake"). The Office Action also rejected Claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Chieu in view of Magana and Miyake. Applicant respectfully submits the pending Claims are allowable for at least the following reasons:

Chieu fails to recite or suggest: 1) the receiving means of the slave units (PP1, PP2) allocating fixed time slots which are not used for a transmission of synchronization signals they are ready to receive or fixed time slots they are ready to receive with a setting which does not allow the reception of signals from the master unit (FP), and 2) the slave units (PP1, PP2) also including transmission means which use one of the time slots in which the receiving means of the slave units (PP1, PP2) are ready to receive,

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but reception of signals from the master unit (FP) is not enabled, in order to transmit signals for initiating a communication between themselves. Rather, Chieu recites a handshake requirement, whereby a base station sends a synchronization transmission (a MUX-1 packet) during the S timeslot which directs that the primary portable unit synchronize with the base station. It then listens in a particular channel for predetermined time periods, such as Tps turn-around time between the base station's transmission and receiving modes for a secondary portable unit. It then sends a calling packet (CP) during Tps and listens for a secondary portable unit during Tpr. The secondary portable unit must then wake from sleep, synchronize with its base station, and listen for the CP. It then acknowledges with an acknowledgement packet (AP) as a second handshake operation to establish communication in an unoccupied channel (see, e.g., Chieu Col. 6, line 33 to Col. 8, line 45). Chieu does not recite or suggest the receiving means of the primary and secondary portable units allocating fixed time slots which are not used for a transmission of synchronization signals they are ready to receive or fixed time slots they are ready to receive with a setting which does not allow the reception of signals from the base station. Rather, a single portable device in Chieu is enabled to begin transmitting to a secondary passive portable device. Chieu also fails to discuss disallowing reception of signals from the base station.

The Office Action argues that Chieu inherently utilizes the portable units for synchronization. Applicant respectfully notes that a missing element is inherently present in a reference only if that element necessarily follows from what has been expressly described, and would be so recognized by one of skill in the art (as opposed to the examiner's expectation). Mere possibilities or even probabilities are not enough; necessity recognized by those of skill in the art is required.¹ The M.P.E.P. echoes this case law.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.

M.P.E.P. § 2112 (emphasis in original) (citations omitted).

Further, the following is also emphasized:

In relying upon the theory or inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

M.P.E.P. § 2112 (emphasis in original) (citations omitted).

It is well established that a recited element or step is inherently present in a prior art reference only if that element is

¹ The Federal Circuit has clearly set out the standard for inherency in, e.g., Continental Can Co. v. Monsanto Co., 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991) (emphasis added):

To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill. In re Oelrich, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981) (quoting Hansging v. Kemmer, 40 U.S.P.Q. 665, 667 (C.C.P.A. 1939)) provides: "Inherency, however may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."

This citation is also set out in M.P.E.P. § 2131.01(d).

necessarily present or necessarily performed in that reference, and further that its presence or performance would be recognized by one of ordinary skill in the art from what has been expressly described. Second, the Office Action must provide objective evidence or cogent technical reasoning to support a contention of inherency.²

Simply because, as the Office Action alleges, Chieu recites communication between two portable devices, this does not necessarily mean the communication is used for synchronization purposes. Applicant respectfully traverses the § 102 rejection of Claim 1 for at least the above reasons.

Claim 9 recites a method for a synchronous TDD system substantially corresponding to the system of Claim 1 and is believed patentable for at least the same reasons.

Claims 2-7 depend from one or another of the independent Claims recited above and are believed patentable for at least the same reasons. In addition, Applicant respectfully believes Claims 2-7 to be independently patentable and request separate consideration of each claim. Further, Applicant respectfully believes the § 103 rejections of Claims 3-8 to be moot in light of the above remarks and requests their withdrawal.

² "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex Parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Applicant's undersigned attorney may be reached by telephone at the number given below.

Respectfully submitted,

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